

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	08/709,930
Filing Date	September 9, 1996
First Named Inventor	GREEN, PHILIP S.
Art Unit	2786
Examiner Name	GARLAND, STEVE
Attorney Docket Number	00287S-004820US
Total Number of Pages in This Submission	

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PTO/SB/21 (08-03)  
1-15-04 CW  
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## ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Suppl. Information Disclosure Stmt. <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): > 32 references > Return Postcard
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Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Townsend and Townsend and Crew LLP Mark D. Barrish	Reg. No. 36,443
Signature		
Date	12/23/03	

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Nancy Pizzo		
Signature		Date	12/23/2003

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 180

Complete if Known

Application Number 08/709,930

Filing Date September 9, 1996

First Named Inventor GREEN, PHILIP S.

Examiner Name GARLAND, STEVEN

Art Unit 2786

Attorney Docket No. 00287S-004820US

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## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:Deposit  
Account  
Number

20-1430

Deposit  
Account  
Name

Townsend and Townsend and Crew LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$ )

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims			** =		X	
Independent Claims			** =		X	
Multiple Dependent				X		

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ )

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Petitions related to provisional applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	180
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid SUBTOTAL (3)

(\$ )180

## SUBMITTED BY

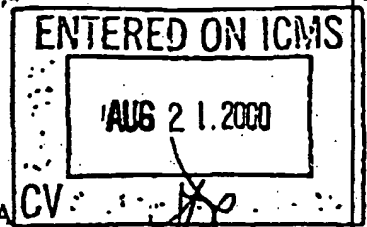
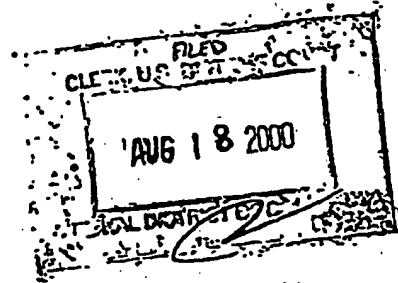
Complete (if applicable)

Name (Print/Type) Mark D. Barrish Registration No. (Attorney/Agent) 36,443 Telephone 650-326-2400

Signature [Signature] Date 12/23/2003

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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
WESTERN DIVISION

COMPUTER MOTION, INC.,

Plaintiff,

vs.

INTUITIVE SURGICAL, INC.,

Defendant.

No. CV 00-4988 CBM (RCx)

ORDER DENYING MOTION FOR  
MORE DEFINITE STATEMENT

The matter before the Court is Plaintiff Computer Motion, Inc.'s Motion for a More  
Definite Statement pursuant to FRCP 12(e).

**I. JURISDICTION**

The Court has jurisdiction pursuant to 28 U.S.C. §§1331 and 1338(a).

**II. BACKGROUND AND PROCEDURAL HISTORY**

This is a patent infringement action relating to computer assisted robotic surgical systems  
for use in minimally invasive surgery. At issue are eight Computer Motion United States  
Patents. Plaintiff alleges that Defendant Intuitive Surgical's computer assisted robotic surgical  
system "da Vinci" infringes on one or more of Plaintiff's patents.

The active complaint is the First Amended Complaint filed on June 1, 2000, alleging  
patent infringement and seeking damages and injunctive relief. On June 30, 2000, Defendant

(54)

1 filed its Answer to the First Amended Complaint and a Counterclaim. On July 21, 2000,  
2 Plaintiff filed this Motion for a More Definite Statement pursuant to FRCP 12(e). On July 31,  
3 2000, Defendant filed an Amended Answer and an Amended Counterclaim. On August 7, 2000,  
4 Defendant filed its Opposition. On August 14, 2000, Plaintiff filed its Reply.

## 5 DISCUSSION

### 6 II. Federal Rule of Civil Procedure 12(e)

#### 7 A. Standard of Law

8 Rule 12(e) of the Fed. R. Civ. P. provides:

9 If a pleading to which a responsive pleading is permitted is so  
10 vague or ambiguous that a party cannot reasonably be required to  
11 frame a responsive pleading, the party may move for a more  
12 definite statement before interposing a responsive pleading.

13 A motion for more definite statement must specify the defects complained of and the details  
14 allegedly required to eliminate the vagueness. Fed. R. Civ. P. 12(e). Motions for more definite  
15 statement are rarely granted and generally disfavored. In re American Int'l Airways, Inc., 66 BR  
16 642, 645 (E.D. Pa. 1986).

#### 17 B. Motion for More Definite Statement

18 Plaintiff argues that Count I of Defendant's Counterclaim relating to Defendant's  
19 inequitable conduct defense is so vaguely pled that Plaintiff cannot reasonably be required to  
20 frame a responsive pleading. Defendant argues that Plaintiff's motion is moot because  
21 Defendant has amended both its answer and counterclaim to include substantially more detail  
22 regarding the allegations of inequitable conduct.

23 Defendant served a copy of the Amended Answer and Counterclaim on Plaintiff on July  
24 31, 2000 with a cover letter stating that Defendant had amended its answer and counterclaim to  
25 address Plaintiff's concern on the inequitable conduct issue. On August 2, 2000, Plaintiff wrote  
26 Defendant a two-sentence letter indicating that it intended to pursue this motion directed at the  
27 original Answer, despite the fact that Defendant had filed its Amended Answer. Defendant's  
28 First Amended Answer substantially adds to Defendant's Fourth Affirmative Defense

1 (Unenforceability Based on Inequitable Conduct) and extensively added to paragraph 20 of  
2 Defendant's Counterclaim.

3 Further, Plaintiff has failed to satisfy the "meet and confer" requirement of Local Rule  
4 7.4.1 with regard to the First Amended Answer. Although Plaintiff has met and conferred with  
5 regard to the initial Answer, there has not been a 7.4.1 meeting with regard to the First Amended  
6 Answer. Defendant argues in its Opposition that it does not know why Plaintiff is proceeding  
7 with this motion in light of the filing of the First Amended Answer, what defects Plaintiff  
8 perceives in the First Amended Answer or what additional information Plaintiff contends it is  
9 entitled to in connection with the First Amended Answer. The only response from Plaintiff prior  
10 to the filing of its Reply was a letter dated August 2, 2000 which states in its entirety "We have  
11 reviewed you [sic] Amended Answer and disagree with your position. Computer Motion's  
12 Motion For A More Definite Statement has not been mooted." Emrich Declaration, ex. 6.  
13 Plaintiff argues in its Reply that Rule 7.4.1 has been met, citing two telephone conversations  
14 between counsel. However, both conversations occurred before the Amended Answer was filed  
15 and refer to Defendant's original Answer.

16 A Rule 12(c) motion is proper only where the pleading is so indefinite that the responding  
17 party cannot ascertain the nature of the claim being asserted and cannot be reasonably expected  
18 to frame a proper response. Famolare, Inc. v. Edison Bros. Stores, Inc. 525 F.Supp. 940, 949  
19 (E.D. Cal. 1981). A motion for more definite statement attacks unintelligibility in a pleading, not  
20 simply mere lack of detail. Therefore, the motion fails where the pleading is specific enough to  
21 apprise the responding party of the substance of the claim being asserted. Bureerong v. Uyawas,  
22 922 F.Supp. 1450, 1461 (C.D. Cal. 1996). In this case, after Plaintiff raised concerns about the  
23 sufficiency of the original Answer, Defendant amended its answer to include more detail. Upon  
24 review of the Defendant's Amended Answer, the Court finds that it provides sufficient detail to  
25 enable Plaintiff to ascertain the nature of the inequitable conduct claim and to frame a proper  
26 response.

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**SO ORDERED.**

C. B. G.

**UNITED STATES DISTRICT JUDGE**

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AUG 21 2000

FISH & RICHARDSON, P.C.  
LA JOLLA CAUNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

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4350 La Jolla Village Dr, Ste 500,  
City/State: San Diego, CA 92122-0  
Fax Number: 858-678-5099

## Fax Notes:

Case 2:00-CV-04988 : COMPUTER MOTION INC V. INTUITIVE SURGIC

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Number of pages including this cover sheet: 05

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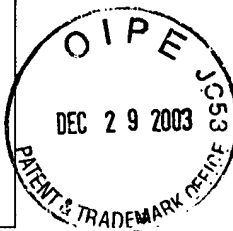
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Alexandria, VA 22313-1450

On Dec. 23, 2003

TOWNSEND and TOWNSEND and CREW LLP

By: Nancy Pizzo  
NANCY PIZZO

Attorney Docket No.: 00287S-004820US  
Client Reference No.: P-3026



Customer No. 20350

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JAN 02 2004

Technology Center 2100

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

PHILIP S. GREEN

Application No.: 08/709,930

Filed: September 9, 1996

For: SURGICAL SYSTEM

Examiner: GARLAND, STEVEN

Art Unit: 2786

INFORMATION DISCLOSURE  
STATEMENT UNDER 37 CFR  
§1.97 and §1.98

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08B is being called to the attention of the Examiner. Copies of the references are enclosed.

It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.



This IDS is being filed before the mailing date of the final Office Action or  
Notice of Allowance.

Please charge the IDS fee of \$180 to Deposit Account No. 20-1430. Please  
deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



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Mark D. Barrish  
Reg. No. 36,443

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San Francisco, California 94111-3834  
Tel: 650-326-2400 / Fax: 650-326-2422  
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